

Attorney Docket No.: **TI-0013**
Inventor: **Taylor et al.**
Serial No.: **09/802,466**
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REMARKS

Claims 1, 2, 4, 6-11, 21, and 26-28 are pending in the instant application. Claims 1, 2, 4, 6-11, 21, and 26-28 have been rejected. Claims 1, 7, and 28 have been amended. No new matter has been added by this amendment. Reconsideration is respectfully requested in light of the following remarks.

I. Rejection of Claims Under 35 U.S.C. §102

Claims 1, 2, 4, 6-11, 21, and 26-28 have been rejected under 35 U.S.C. §102(e) as being anticipated by Gjerde et al. (U.S. Patent Application No. 20030165941). Claims 7-10, 26 and 28 have also been rejected under 35 U.S.C. 102(a) as being anticipated by Oefner (U.S. Patent No. 6,453,244). Applicants respectfully traverse this rejection.

The methods disclosed in Gjerde et al. and Oefner fail to teach the separation of a polynucleotide molecule from any other type of macromolecule, e.g., an RNA degrading agent, thereby stabilizing the RNA molecule against degradation. Further, these references fail to teach or suggest conditions for achieving such a separation. For example, Applicants appreciated that separation columns having an inner diameter of greater than about 5 mm dramatically improve RNA fractionation. See page 28, lines 4-18, and Example 11 of the instant specification. In contrast, the methods disclosed by Gjerde et al. and Oefner were conducted using columns having an inner diameter of 4.6 mm. See paragraphs [0467], [0468], and [0471] of Gjerde et al. See column 17, lines 20-23 and column 19, lines 40-45 of Oefner. Accordingly, in an earnest effort to facilitate the prosecution of the instant application, Applicants have amended base claims 1, 7, and 28 to

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recite the technical feature of a separation column having an internal diameter of greater than about 5.0 mm. In light of these amendments, the cited references fail to teach every element of the claim. Withdrawal of these rejections is therefore respectfully requested.

II. Rejection of Claims Under 35 U.S.C. §103

Claims 1, 2, 4, 6, and 21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Oefner (U.S. Patent No. 6,453,244) in view of Petro et al. (U.S. Patent No. 6,260,407). Claims 11 and 27 also stand rejected under 35 U.S.C. 103(a) as being unpatentable over Oefner in view of Petro et al. further in view of Sheridan and Sheridan ((1989) *Scientist* 3(4)23). Applicants respectfully disagree.

As indicated *supra*, Oefner et al. fails to teach or suggest conditions (*i.e.*, column inner diameters of greater than about 5 mm) for separation of an RNA molecule from an RNA degrading agent, thereby stabilizing the RNA molecule against degradation. Further, there would be little motivation to modify the teachings of Oefner, as various inner diameters were not used to demonstrate that different inner diameters were more suitable for different applications. Moreover, Petro, and Sheridan and Sheridan also fail to appreciate this technical feature of optimal RNA fractionation. Accordingly, because the cited references fail to provide some suggestion or motivation to modify the reference teachings or to combine the reference teachings, they fail to make the instant invention obvious. It is therefore respectfully requested that these rejections be withdrawn.

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III. Conclusion

The Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,



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